

REMARKS

The following remarks are fully and completely responsive to the Office Action dated January 4, 2005.

Claims 1 and 11 have been amended. Applicants submit that the amendments made herein are fully supported by the disclosure of the application as originally filed, and therefore no new matter has been added. Accordingly, claims 1-11 are pending in the present application and are respectfully submitted for reconsideration.

Claim Objection

Claim 11 has been amended to correct the minor informality highlighted by the Examiner. Applicants therefore request withdrawal of the objection.

Rejection under 35 U.S.C. § 103(a)

Claims 1, 3-4, 6 and 9 were rejected under 35 U.S.C. §103(a) as being unpatentable over Lipps *et al.* (U.S. Patent No. 5,741,182, hereinafter “Lipps”) in view of Lipsons (U.S. Patent No. 5,435,554). Applicants respectfully traverse the rejection and submit that each of these claims recites subject matter that is neither disclosed nor suggested by the cited prior art.

Claim 1 recites a sensing ball game apparatus comprising, among other features, a game processor for receiving the acceleration correlated signal and causing a change in the ball character being displayed on the screen based on the acceleration correlated signal.

It is respectfully submitted that the prior art fails to disclose or suggest at least the above-mentioned features of the Applicants' invention.

The Office Action characterized Lipps as allegedly disclosing,

a game processor is utilized for causing a change in the batter displayed on a screen (column 3, lines 13-17; Fig. 1). Lipps et al. teaches that the batter's swing is sensed via a centrifugal switch and the appropriate signals are transmitted to a game system. When the bat is swung, the centrifugal force (acceleration correlated signal) causes a weight to move toward a switch. At swing speeds faster than some critical speed (predetermined level), the weight has enough force to actuate the switch (column 5, lines 58-67; column 6, lines 12-26). See, paragraph 4 of Office Action. (Emphasis added)

In addition, the Office Action noted that "Lipps et al. fails [sic] to explicitly teach causing a change in the ball character being displayed on the screen," and relies on Lipson for teaching "that once the result of the hit ball is determined, flow enters state 404 where the appropriate animation sequence is displayed on the video screen to include the previously hit ball and the advancement of any runners on base (column 12, lines 32-42)."

Applicants submit that neither Lipps nor Lipson disclose or suggest each and every element recited in claim 1 of the present application for at least the following reasons.

It is submitted that the centrifugal force of Lipps is neither comparable nor analogous to the presently claimed element of "an acceleration correlated signal." Lipps merely discloses "a centrifugal switch, consisting of a small steel weight, a guide to allow the weight to move, and a switch that is activated by the

force of the moving weight." Lipps further discloses that "when the bat is swung, the centrifugal force causes the weight to move toward the switch" and "at swing speeds faster than some critical speed, the weight has enough force to actuate the switch." See, Lipps, column 6, lines 12-15 and lines 23-26.

Applicants submit that the centrifugal switch of Lipps is merely a mechanical function, wherein the movement of the weight within the bat triggers a mechanical switch response. Hence, Lipps fails to generate a calculated electrical signal. In contrast, the present invention provides an acceleration signal that is derived from measuring and calculating an acceleration-related value, which is an electrical function and response. For example, the acceleration correlated signal of the present invention is a signal having a magnitude changed in correlation to a magnitude of the acceleration that is applied to the input device.

Furthermore, it is submitted that the cited prior art fails to teach or suggest at least the feature of "a game a processor for receiving the acceleration correlated signal and causing a change in the ball character being displayed on the screen based on the acceleration correlated signal." Applicants concur with the Examiner's position that the primary reference of Lipps "fails to explicitly teach causing a change in the ball character displayed on the screen."

Yet, the secondary reference of Lipson merely discloses the calculation of ball trajectory (i.e., ball character) and changes in animation sequence displayed on the video screen. However, Applicants submit that the change in ball character displayed on the screen, as disclosed by Lipson, is neither equivalent

nor comparable to the change in ball character of the presently claimed invention. Specifically, Lipson merely teaches “pitch quality” and “swing timing” as the factors calculated to determine ball character. Moreover, Lipson provides that the “ball trajectory is determined by the initial hit angle and the initial velocity of the ball coming off the bat.” However, there is no teaching or suggestion that Lipson considers acceleration as a factor when calculating the movement of the input device.

Therefore, Applicants submit that Lipps in view of Lipson fail to disclose each and every element recited in claim 1 of the present application.

To establish *prima facie* obviousness, each feature of a rejected claim must be taught or suggested by the applied art of record. See M.P.E.P. §2143.03 and *In re Royka*, 490 F.2d 981 (CCPA 1974). As explained above, Lipps and Lipson, taken alone or in combination, do not teach or suggest each feature recited by pending Claim 1. Accordingly, for the above provided reasons, Applicants respectfully submit that pending Claim 1 is not rendered obvious under 35 U.S.C. § 103 by the teachings of Lipps and Lipson, and therefore is allowable.

As claims 2-4, 6 and 9 depend from claim 1, Applicants submit that each of these claims incorporates the patentable aspects therein, and are therefore allowable for at least the reasons set forth above with respect to the independent claims, as well as for the additional subject matter recited therein.

References Not Combinable

Moreover, Applicants submit that the cited references are not combinable

because each of the references disclose significantly different operations and game play. For example, the joystick input device as provided by Lipson fails to operate in the same manner as the output disclosed in Lipps, and therefore are not combinable to function according to the present invention. It is submitted that one skilled in the art would conclude that the structural configuration of a joystick as an input device is significantly incompatible with a swingable input device such as in Lipps. Specifically, the structural components of the joystick fail to provide an output, nor be able to provide an output of a signal based on the velocity of the movement. Consequently, the processors in Lipson would be different from (in structure and in function) and not combinable with, the processor in Lipps. Thus, Applicants submit that the cited prior art are not combinable.

Under U.S. patent practice, the PTO has the burden under §103 to establish a *prima facie* case of obviousness. In re Fine, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Both the case law of the Federal Circuit and the PTO itself have made clear that where a modification must be made to the prior art to reject or invalidate a claim under §103, there must be a showing of proper motivation to do so. The mere fact that a prior art reference could arguably be modified to meet the claim is insufficient to establish obviousness. The PTO can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. Id. In order to establish obviousness, there must be a suggestion or motivation in the reference

to do so. See also *In re Gordon*, 221 USPQ 1125, 1127 (Fed. Cir. 1984) (prior art could not be turned upside down without motivation to do so); *In re Rouffet*, 149 F.3d 1350 (Fed. Cir. 1998); *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999); *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002). The Office Action restates the advantages of the present invention to justify the combination of references. There is, however, nothing in the applied references to evidence the desirability of these advantages in the disclosed structure.

Applicants respectfully request withdrawal of the rejection.

Claims 5, 7, 8, 10 and 11 Rejected Under 35 U.S.C. § 103(a)

Claims 5 and 8 were rejected under 35 U.S.C. §103(a) as being unpatentable over Lipps and Lipson in view of Tosaki et al. (US Patent No. 6,517,438, hereinafter “Tosaki”).

Claim 10 was also rejected under 35 U.S.C. § 103(a) as being unpatentable over Lipps and Lipson in view of Zur et al. (US Patent No. 6,517,438, hereinafter “Zur”).

Furthermore, claims 7 and 11 were rejected under 35 U.S.C. §103(a) as being unpatentable over Lipps and Lipson in view of Marinelli (US Patent No. 6,157,898).

Applicants respectfully traverse the rejection and submit that each of these claims recites subject matter that is neither disclosed nor suggested by the cited prior art.

Applicants submit that neither Tosaki, Zur nor Marinelli make up for the deficiencies of Lipps in view of Lipson discussed above. And as claims 5, 7, 8,

10 and 11 depend from claim 1, Applicants submit that each of these claims incorporates the patentable aspects therein, and are therefore allowable for at least the reasons set forth above with respect to the independent claims, as well as for the additional subject matter recited therein.

Conclusion

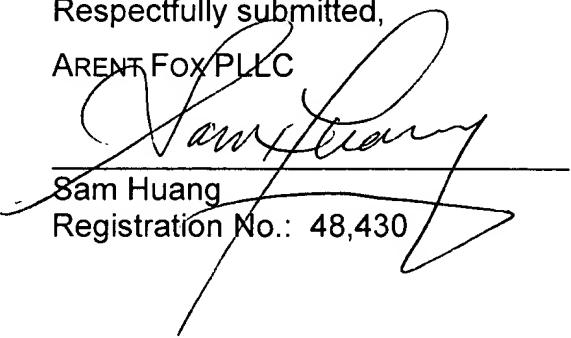
In view of the foregoing, reconsideration of the application, withdrawal of the outstanding rejections, allowance of claims 1-11 and the prompt issuance of a Notice of Allowability are respectfully solicited.

Should the Examiner believe anything further is desirable in order to place this application in better condition for allowance, the Examiner is requested to contact the undersigned at the telephone number listed below.

In the event this paper is not considered to be timely filed, Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to counsel's Deposit Account No. 01-2300, **referencing** docket number **100341-00008**.

Respectfully submitted,

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